



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,839	11/19/2003	Alain Lagrange	06028.0032-00	3618

22852 7590 08/31/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

ELHILO, EISA B

ART UNIT PAPER NUMBER

1751

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,839

Applicant(s)

LAGRANGE ET AL.

Examiner

Eisa B. Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-76 is/are pending in the application.
- 4a) Of the above claim(s) 27-44, 46 and 47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-26, 45, 48-54 and 69-76 is/are allowed.
- 6) ☒ Claim(s) 55-57, 59, 66 and 67 is/are rejected.
- 7) ☒ Claim(s) 58, 60-65 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1 This action is a responsive to the amendment filed on July 13, 2006.

2 Claims 55-57, 59, 66 and 67 stand rejected under 35 U.S.C. 102(b) as being anticipated
by Leugs et al. (US 6,160,037) for the reasons set forth in the previous office action mailed on
March 23/2006.

3 Claims 58, 60-65 and 68 objected to for the reasons set forth in the previous office action
mailed on March 23/2006.

4 Claims 20-26, 45, 48-54 and 69-76 are allowed for the reasons set forth in the previous
office action mailed on March 23/2006.

5 Claims 27-44, 46 and 47 are withdrawn from consideration for the reasons set forth in
the previous office action mailed on March 23/2006.

Response to Applicant's Arguments

6 Applicant's arguments filed 7/13/2006 have been fully considered but they are not
persuasive.

With respect to the applicant's arguments based on the election of the species mailed
11/2/2005, the examiner would like to point out that the claims are directed to latent pigments
chosen from species formulae which are patentably independent and distinct and they are
classified and searched in different classes and subclasses and the search required for each group
is not required for the other groups of the species. Further, each group of these claimed species
forms a separate invention by it self. Therefore, restriction for examination purposes as indicated
is proper.

Art Unit: 1751

With respect to the rejection of claims 55-57, 59, 66 and 67 under 35 U.S.C. 102(b) as being anticipated by Leugs et al. (US 6,160,037), Applicant argues that Leugs et al. (US' 037) does anticipate the claims because the disclosure of Leugs et al. does not teach or disclose a cosmetic composition for dyeing keratin fibers as claimed.

The examiner respectfully disagrees with the above arguments because in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility be disclosed by the reference. *In re Schoenwald*, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992) (The application claimed compounds used in ophthalmic composition to treat dry eye syndrome. The examiner found a printed publication, which disclosed the claimed compound but did not disclose a use for the compound. The court found that the claim was anticipated since the compound and a process of making it was taught by the reference. The court explained that "no utility need be disclosed for a reference to be anticipatory of a claim to an old compound." 964 F.2d at 1124, 22 USPQ2d at 1673. It is enough that the claimed compound is taught by the reference. In this case Leugs et al. (US' 037) clearly teaches the claimed pigments and alcohols as claimed (see col. 2, formula (I) and col.30, Example 11). Therefore, the anticipation rejection is proper and maintained.

7 **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

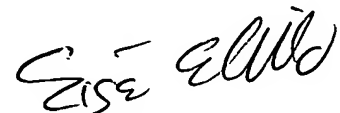
Art Unit: 1751

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Eisa Elhilo
Primary Examiner
Art Unit 1751

August 27, 2006